BoxInterference@uspto.gov
Telephone; 571-272-4683

Paper 343
Filed: May 2, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MIHAL **LAZARIDIS** and GARY P. MOUSSEAU
Junior Party
(Patent No. 6,219,694)[1]

v.

GENE **EGGLESTON**, MITCH HANSEN,
and RICHARD KREBS
Senior Party
(Application ~~09/095,325~~)[2]

Patent Interference No. 105,700
(Technology Center 2100)

Before JAMESON LEE, RICHARD TORCZON and SALLY C. MEDLEY, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

Judgment – Merits – Bd. R. 127

---

1 Based on Application 09/087,623, filed May 29, 1998. The real party in interest is Research in Motion Limited.

2 Filed June 10, 1998. Accorded the benefit of Application 08/574,528, filed December 19, 1995. The real party in interest is Motorola, Inc.

In a concurrent paper, we have determined that all of Eggleston's claims corresponding to the count are unpatentable under 35 U.S.C. § 112, first paragraph, for lack of written description in the specification. Accordingly, as an applicant who provoked the interference against Lazaridis, Eggleston is without standing to continue in this interference. It is

ORDERED that judgment on priority as to Count 1 is entered against senior party GENE EGGLESTON, MITCH HANSEN, and RICHARD KREBS;

FURTHER ORDERED that senior party's claims 56-63 and 65 of Application 09/095,325, which correspond to Count 1, are FINALLY REFUSED;

FURTHER ORDERED that the parties shall note the requirements of 35 U.S.C. §135(c) and Bd.R. 205; and

FURTHER ORDERED that a copy of this judgment shall be entered into the file of Application 09/095,325, and Patent 6,219,694.

By Electronic Transmission:

Attorney for Junior Party Lazaridis:

Barbara Clarke McCurdy, Esq.
Steven L. Park, Esq.
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
901 New York Avenue, N.W.
Washington, D.C. 20001-4413

Tel: 202-408-4000
Email: barbara.mccurdy@finnegan.com
Email: steven.park@finnegan.com

Attorney for Senior Party Eggleston:

Charles L. Gholz, Esq.
W. Todd Baker, Esq.
Alexander B. Englehart, Esq.
Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Va 22314

Tel: 703-413-3000
Email: cgholz@oblon.com
Email: tbaker@oblon.com
Email: aenglehart@oblon.com

BoxInterferences@uspto.gov
Telephone: 571-272-4683

Paper 342
Filed: May 2, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MIHAL **LAZARIDIS** and GARY P. MOUSSEAU
Junior Party
(Patent No. 6,219,694)

v.

GENE **EGGLESTON**, MITCH HANSEN,
and RICHARD KREBS
Senior Party
(Application 09/095,325)

Patent Interference No. 105,700
(Technology Center 2100)

Before JAMESON LEE, RICHARD TORCZON and SALLY C. MEDLEY, *Administrative Patent Judges*.

Decision – Motions -- Bd. R. 125(b)

LEE, *Administrative Patent Judge*; with TORCZON, *Administrative Patent Judge*, joining *dubitante*.

Introduction

This interference was declared on July 23, 2009. Pending before us are Lazaridis Motions 1-4 and 6 and Eggleston Motions 1 and 3. Oral argument was held on September 23, 2010.

Lazaridis Motion 1 asserts that all of Eggleston's claims corresponding to the count are unpatentable for not satisfying the written description requirement of 35 U.S.C. § 112, first paragraph.

Lazaridis Motion 2 asserts that all of Eggleston's claims corresponding to the count are unpatentable for indefiniteness under 35 U.S.C. § 112, second paragraph.

Lazaridis Motion 3 asserts that all of Eggleston's claims corresponding to the count are unpatentable over prior art.

Lazaridis Motion 4 seeks to designate Lazaridis claims 1-23, 32, and 34-36 as not corresponding to the count.

Lazaridis Motion 6 seeks to exclude certain evidence of Eggleston.

Eggleston Motion 1 asserts that all of Lazaridis claims corresponding to the count are unpatentable over prior art.

Eggleston Motion 3 seeks to exclude certain evidence of Lazaridis.

Discussion

Lazaridis is involved on the basis of Patent 6,219,694, based on Application 09/087,623, filed May 29, 1998, and its real party in interest is Research in Motion Limited. Eggleston is involved on the basis of Application 09/095,325, filed June 10, 1998, and its real party in interest is Motorola, Inc.

Upon declaration of the interference, the Lazaridis claims corresponding to the count are claims 1-36, and the Eggleston claims corresponding to the count are claims 56-63 and 65.

A. Lazaridis Motion 1

To satisfy the written description requirement under 35 U.S.C. § 112, first paragraph, the specification must convey with reasonable clarity to those skilled in the art that as of the filing date of the application the inventor was in possession of the claimed invention. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991).

The Eggleston claims subject to attack by this Lazaridis motion are claims 56-63 and 65. Claims 56, 60 and 65 are the only independent claims.

All of Eggleston's claims are about forwarding a message generated at a mobile client, by use of a forwarding component at a host system where the message sender has an associated address. Claim 56 refers to that address as an email address. Claims 60 and 65 refer to that address as a first address. It is understood and not in dispute that in these claims the mobile client is not identifiable by the sender's address associated with the host system.

The parties also do not dispute that Eggleston's claims corresponding to the count, claims 56-63 and 65, were initially copied from Lazaridis' involved patent and subsequently amended in response to a rejection for lack of written description. In our view, the Eggleston claims still remain essentially copied from the involved Lazaridis patent despite the amendments. The claims are much closer to Lazaridis claims than any preexisting Eggleston claim prior to the initial copying. Thus, for purposes of claim construction in this motion alleging lack of written description under 35 U.S.C. § 112, first paragraph, the proper context of

interpretation is the specification of the Lazaridis patent. *Agilent Technologies, Inc. v. Affymetrix, Inc.*, 567 F.3d 1366, 1375 (Fed. Cir. 2009).

At issue in this motion are claim features regarding what the forwarding component does at the host system upon receiving a message generated at a mobile client by the message sender for a message recipient, prior to forwarding the message to the message recipient. The pertinent language setting forth what the forwarding component does at the host system is noted below.

Claim 56 recites: "**configures the received message**, prior to forwarding to the message recipient, **such that the received message appears to** the message recipient as if the received message **originated at the sender's email address** associated with the host system, thereby allowing **messages generated at either the mobile client or host system to appear to originate at the sender's email address** associated with the host system." (Emphasis added.)

Claim 60 recites: "**configuring the received message such that** the received message **appears to** the message recipient as if the received message **originated at the sender's first address**, wherein **messages generated at either the mobile client or host system appear to originate at the message sender's first address**." (Emphasis added.)

Claim 65 recites: "**configuring the received message such that the received message appears as if it were generated at either the mobile client or host system**." (Emphasis added.)

The above-noted independent claims all require the forwarding component to configure the message received from the mobile client in a way that the message

recipient cannot tell that the message originated at a mobile client. Claims 56 and 60 further require that messages generated at the mobile client will be made to appear as though they originated with the message sender's address associated with the host system. The concept is transparency of the mobile client, *i.e.*, it remains unseen by the recipient that a mobile client "originated" the message.

The transparency feature is noted in the Lazaridis patent disclosure, *i.e.*, the mobile device is made to appear "transparent" -- meaning that one does not know that a mobile unit is involved. (Exhibit 2001, 10:16-19). We note also that Eggleston regards the so called "transparency" feature as meaning that the receiver of a message cannot tell whether the message came from the host system or the mobile client. (Eggleston Motion 2, Material Facts 17 and 29).

All other claims depend on claim 56, 60, or 65, and include all the features of the base independent claim.

We interpret two terms, "configure" and "appear." Neither term is specially defined in Lazaridis' specification. Both are used simply as an ordinary term apparently well understood by one with ordinary skill in the art. Lazaridis' specification gives an example of the action performed at the forwarding component in the host (Exhibit 2001, 8:66 to 9:19):

> If the redirected user data item is an E-mail message, as described above, the user at the mobile device 24 sees the original subject, sender's address, destination address, carbon copy and blind carbon copy. When the user replies to this message, or when the user authors a new message, **the software operating at the mobile device 24 adds a similar outer envelope** to the reply message (or the new message) to cause the message to be routed first to **the user's host system 10, which then removes the outer envelope** and redirects the

> message to the final destination, such as back to computer 26. In the preferred embodiment, this results in the outgoing redirected message from the user's host system 10 being sent using the E-mail address of the host mailbox, rather than the address of the mobile device, **so that it appears** to the recipient of the message that the message **originated from the user's desktop system 10 rather than the mobile data communication device**. Any replies to the redirected message will then be sent to the desktop system 10, which if it is still in redirector mode, will repackage the reply and resend it to the user's mobile data service, as described above. (Emphasis added.)

We have read the specification of Lazaridis' involved patent and conclude that the term "appear" does not carry any specially defined meaning but means just what it appears to say, *e.g.*, indicates, shows. We are cognizant that there are many ways a recipient may ascertain the origin of a message, including looking at any transmission path information or description of the forwarded nature of a message. We conclude that to make a message appear as though it "originated" with either the host system or the mobile client and thus not specifically with the mobile client, information identifying the mobile client as the point of origination must be excluded from the forwarded message. The mobile client identification and any description of the forwarded nature of the message from a mobile client must be excluded from the forwarded message to present the desired appearance.

Note the following text in the specification of the Lazaridis patent, which expressly states the goal of making a message being forwarded from the mobile client appear as though it "originated" from a desktop PC (Exhibit 2001, 9:2-14):

> When the user replies to this message, or when the user authors a new message, the software operating at the mobile device 24 adds a similar outer envelope to the reply message (or the new message) to

> cause the message to be routed first to the user's host system 10, **which then removes the outer envelope** and redirects the message to the final destination, such as back to computer 26. In the preferred embodiment, this results in the outgoing redirected message from the user's host system 10 being sent using the E-mail address of the host mailbox, rather than the address of the mobile device, **so that it appears to the recipient of the message that the message originated from the user's desktop system 10 rather than the mobile data communication device**. (Emphasis added.)

It is important to not include information which reveals the forwarded nature of the message and the mobile client as the originating source of the message.

We have read the specification of Lazaridis' involved patent and conclude that the term "configure" does not carry any specially defined meaning but is used as a general action verb meaning to create, arrange, accomplish, achieve, or make something happen. For instance, when describing the creation of a list, the Lazaridis specification states (Exhibit 2001, 8:18-24):

> The user of the host system 10 can **configure the preferred list** directly from the desktop system, or, alternatively, the user can then send a command message (such as C) from the mobile device 24 to the desktop system 10 to activate the preferred list mode, or to add or delete certain senders or message characteristics from t**he preferred list that was previously configured.**

With respect to other actions, Lazaridis similarly generally uses the word "configure" to mean create or arrange (Exhibit 2001, 10:39-46):

> The method steps carried out by the redirector program 12 are described in more detail in FIG. 4. The basic functions of this program are: (1) configure and setup the user-defined event trigger points that will start redirection; (2) configure the types of user data

> items for redirection and optionally configure a preferred list of senders whose messages are to be redirected; (3) configure the type and capabilities of the user's mobile data communication device; (4) receive messages . . . .

Lazaridis Motion 1 presents at least a prima facie case that Eggleston's specification does not provide written description for Eggleston's claims 56-63 and 65, as is required by 35 U.S.C. § 112, first paragraph.

Lazaridis correctly notes that Eggleston's specification nowhere "discusses" configuring, *i.e.*, making or arranging, any message received by a forwarding component in a host system from a mobile client to make it appear as though it "originated" with an address of the sender associated with the host. That is not disputed by Eggleston. Lazaridis also has shown that Eggleston's specification does not anywhere "discuss" configuring, *i.e.*, making or arranging, a received message such that the ultimate message recipient becomes unable to tell whether the received message was actually first generated at a mobile client. Eggleston's specification does not appear concerned with or interested in making it not ascertainable by the ultimate message recipient whether the message originated at a mobile client. Instead, as is explained by Lazaridis, Eggleston's disclosed invention is ostensibly about some other inventive concept, *i.e.*, monitoring and controlling the amount of wireless communication between a remote unit and a host server. (Exhibit 2002, Abstract).

Lazaridis specifically discusses the Figure 9 embodiment in Eggleston's disclosure, which describes the implementation of an optimized reply message from a mobile communication device. That embodiment seeks to minimize the

wireless communication used to transmit a reply message from a mobile remote client. It is recognized the original message need not be retransmitted from the mobile remote unit as a part of the reply, because that original message came from the host server and can be added to the reply at the host server. Pertinent portions of Eggleston's disclosure are reproduced below (Exhibit 2002, ¶¶ 44, 46-47):

> [0044] Starting from a client perspective, the process of FIG. 9 commences with a client formulating a reply to a received mail message, much as he or she would for any typical email application (step 902). However, when the user executes the reply, e.g., by clicking on a send button, the client controller (201 of FIG. 2) optimizes the reply message by calculating a delta or difference, using any appropriate delta routine, between the reply message and the preceding message. This delta is then formed into an optimized reply along with a message/data unit identifier for preceding message/data unit (preferably the mail serial number, although any retrievable identifier of the preceding message may be used, such as header information, or even a CRC (cyclic redundancy check) value)(step 904). . . .
>
> [0046] In cases where the target unit is not an active client with the communications server, the QM (or other appropriate entity of the controller) functions to reconstruct the reply message from the optimized reply. Because the communication server preferably does not retain a copy of client mail or data located on other hosts (such remote stores typically adding complexity and cost, while being unnecessary in view of the virtual session established via the communication server), it would use the identifier to retrieve the preceding message from the host (e.g., send a query object or message to the appropriate post office) (steps 908-912). . . .
>
> [0047] Once the preceding message has been received by the communication server, it uses a counterpart delta routine to that of the client to reconstruct a replica of the reply message from the delta of

> the optimized reply and the retrieved copy of the preceding message. **Once reconstructed, the reply message is forwarded to the target unit(s), as well as to the outbox or sent mail folder of the client's post office box (steps 914-916).** While some additional processing and network traffic is required between the communication server and host, this is relatively inexpensive compared to the savings achieved by using an optimized reply over the tariffed network between the communication server and client. (Emphasis added.)

Citing the testimony of its technical witness Dr. Gary Tjaden (Exhibit 2005, ¶ 44), Lazaridis states that sending the reply message to the outbox or sent mail folder of the client's post office box does not describe making the sent message appear to the recipient receiving that message as though it originated at the sender's address associated with the host. (Motion 4:8-10). The position is reasonable, at least for making out a prima facie case of entitlement to relief. Sending the reply message to the outbox or sent mail folder of the client's post office box does not say anything about whether identification information of the mobile client at which the reply message originated is excluded from the reply message being forwarded. It also does not say anything about excluding transmission path and history information or a simple descriptor that indicates the message was forwarded.

For instance, if the identifier of the mobile client is taken from the message originating from the mobile client and included in the forwarded reply, perhaps in a segment specifying the original source or transmission path history, then even if the forwarded message also shows an address associated with the host, it would not appear to the recipient that the message originated with that address. The identifier of the mobile client or the transmission path data would indicate otherwise. And if

the mobile client identifier and the descriptive modifier "Forwarded" or "Fw" are included somewhere in the forwarded reply, the message recipient would not think the message originated at either the host system or the mobile client. Rather, the recipient would think the message originated at the mobile client and was forwarded by the host system. The key here lies in the claims' recitation of the term "originated" which excludes the case of forwarding through the host address.

For the foregoing reasons, Lazaridis has made out a prima facie case that Eggleston's claims 56-63 and 65 lack written description in the specification as is required by 35 U.S.C. § 112, first paragraph. That shifts the burden of going forward to Eggleston, to point out where in its specification such written description exists, particularly if it is Eggleston's position that the written description exists by way of inherency.

Before proceeding further with our analysis, it is noted that not all of the arguments of Lazaridis have merit. For example, we reject the Lazaridis argument based on the possibility of "spoofing," where the host system in Eggleston's disclosure allegedly may forward an email which has a sender email address that is not associated with the host system but some other email address provided by the user sending the reply through the host system. Lazaridis asserts that one of ordinary skill in the art in 1995 would have known that a message sender could insert any address into the "From:" field and not just the address associated with the host system doing the message sending. (Motion 12:9-12). Lazaridis states that a message sender at a mobile client can insert any address into the "From:" field of a message and need not insert the sender's address associated with the host system which will forward the message to the intended recipient. (Motion 12:16-

20). Lazaridis further argues that the host system does not necessarily change or check the "From:" field of a message being forwarded to make sure that it includes an address that is in fact associated with the host system. (Motion 12:20 to 13:2).

In our view, the arguments of Lazaridis relating to potential spoofing are misplaced. Eggleston's disclosure does not describe anything of the sort, *i.e.*, that the host system sends out a message which identifies the sender by an address that is "not" associated with the host system. Even if that capability exists, it does not take away from the understanding of one with ordinary skill in the art on what Eggleston's disclosure reasonably conveys, *i.e.*, that the inventors are in possession of the feature that the host system forwards a message generated by a sender at a mobile client, by using an email system located at the host system and designed to send and receive email for the sender. Given that the message is a reply to an original message received at the host system for the sender now sending the reply, it is implicit that the sender's email address associated with the host system will be used unless the specification indicates otherwise. There is no such indication. One with ordinary skill in the art would have recognized that Eggleston's inventors possessed using the sender's address associated with the host system when using the host system to send a message for the sender, particularly when the message to be sent is a reply to an initial message received by the host system for the sender.

The same cannot be said of the "appearance" feature requiring transparency of the mobile unit, *i.e.*, excluding all identification of the mobile client anywhere in the reply as the source of origination for the message sent. That is not implicit in Eggleston's disclosure, even assuming that an email address associated with the host system is used for the sender in the reply.

We also reject the argument of Lazaridis that because the reply sent from the mobile client to the host system may already have filled in the "From:" field of the message to be forwarded to the ultimate recipient, the configuring of Eggleston is not performed at the host system as is required by the Eggleston claims. The argument is without merit, as we do not construe "configure" so narrowly as to require an actual change to be performed in the "From:" field of the message being forwarded by the host system. If the host system recognizes that the "From:" field is already properly indicated and simply allows that indication to be carried forth to the forwarding message being sent, that is sufficient to meet the feature. In any event, the Eggleston disclosure does not describe that the sender at the mobile client completes the "From:" field of the reply message.

Despite our disagreement with many of Lazaridis' arguments, we have explained above why Lazaridis has, nonetheless, made out a prima facie case that the Eggleston specification lacks written description for the subject matter of Eggleston's claims 56-63 and 65. That shifts the burden of moving forward to Eggleston who in its opposition must point out where it believes the written description exists and why it believes certain description is inherent.

We are not persuaded by Eggleston's arguments.

First, we have interpreted the claim terms at issue in light of Lazaridis' specification, as Eggleston believes they should be for purposes of deciding Lazaridis' Motion 1. Also, although Eggleston states that the claim terms mean different things in each party's specification, it has not explained the differences.

Eggleston refers to the issue in dispute as pertaining to the "transparency" feature and argues that we should regard as highly probative another Board panel's

decision in 2005 in an ex parte appeal of Eggleston's involved application from an Examiner's rejection of certain Eggleston claims having the transparency feature as lacking written description under 35 U.S.C. § 112, first paragraph. In that prior decision on ex parte appeal, the Board reversed the written description rejection.

As Eggleston has correctly pointed out, the prior Board decision is non-binding. The following represents the analysis in that Board decision (Exhibit 2017, 9:7-18):

> For example, at page 22, describing Figure 9, it is disclosed that messages are retrieved from the communication server, and a delta routine is applied thereto in order to reconstruct a replica of the reply message. Once reconstructed, the reply message is "forwarded to the target unit(s), as well as to the outbox or sent mail folder of the client's post office box (steps 914-916)." It seems clear, then, that the user does not e-mail directly from his mobile unit, i.e., the mobile client does not have an e-mail address or e-mail functionality, but that the host server provides the e-mail address and forwards e-mail to recipients **who are unaware of any address from the mobile client**. (Emphasis added.)

We agree with and adopt all of the above-quoted analysis of the prior Board opinion, except for the very last phrase reproduced in bold. On the record before us, there is no basis to assume that the forwarding component in the host system excludes from the message being forwarded all identification information about the mobile client from which the reply message originated. That is so even though the host system provides the sender's address associated with the host. The two are not the same. If the forwarding agent inserts identification information about the mobile client or transmission path history information, to indicate its status as a forwarding agent, and perhaps even includes the notation "Fw:" in the forwarded

message, then the mobile client would not be transparent to the recipient. The recipient would know the message was forwarded through the host system from a mobile client. The Eggleston disclosure simply does not say anything, explicitly, implicit, or inherently, about "not" including identification of the mobile client and any information indicating the mobile client as the original source of the message.

A forwarded email message may possibly include added information about the source of the original message, to reveal to the message recipient the original source of the message. Eggleston makes no explanation of why it necessarily is the case that in its disclosed system the forwarding component makes sure not to include in the forwarded message any identification information about the source mobile client and not to include transmission path and history data which indicate to the message recipient that the originating source is the mobile client. In that regard, the message recipient may desire to know that the sender is sending a message through the host by use of a mobile client. We do not find that the so called "transparency" feature is inherently disclosed in Eggleston's specification. Exclusion of identification of the mobile client and transmission path history information indicating the mobile client as the originating source does not necessarily occur. Nothing in the Eggleston specification expresses a desire to keep non-ascertainable from the received forwarded message that the mobile client is the originating source of the message.

We have considered Eggleston's argument asserting that its Figure 1 provides the background for the Figure 9 embodiment that inherently discloses the transparency feature. In summary, Eggleston argues (Opposition 6:7-14):

> Thus, Figure 1 provides the background for the inherent disclosure of the transparency feature in Figure 9 through its teaching of allowing the client to have "almost the same access as if directly connected to the host's LAN." With this kind of access to the host's LAN, the mobile client would naturally have access to the client user's normal email address on the LAN, and thus would be able to send and receive email from that address without the other party to the email being able to discern the client's location. That is, Figure 9's specific implementation of the transparency feature through its specialized "configuring" techniques is only a refinement of what is already disclosed in Figure 1 and throughout the Eggleston application.

The above-quoted argument is misplaced. Eggleston's disclosure is ostensibly about minimizing the information transmitted between the host system and the mobile client to increase communication efficiency. Even assuming that the quotation in connection with Eggleston's Figure 1 means the mobile client has actual access to most resources on the host LAN, it does not necessarily mean the mobile client has direct access to email and messages on the host system. Even if it does, that would not help Eggleston's position because the claims require messages from the mobile client to be forwarded by a component in the host system that receives the message. To the extent the quotation suggests that a mobile client may have access to the client user's normal email address on the LAN, it would only be possible, but not inherent, that the client user's email address associated with the host may be identified in an email message originating from the mobile client. That is still not helpful to Eggleston, because according to the claims an address associated with the host is configured by a forwarding

component at the host and the claims do not require identification by the mobile client of the user's address associated with the host system.

In any event, none of this in any way converts the Eggleston Figure 9 embodiment into one in which the forwarding component in the host system excludes from the forwarded message the identification of the mobile client and any transmission path history information which reveals the origin of the message as the mobile client. Simply including in the message an address associated with the host "without" excluding information indicating the mobile client as the originating source is not enough. With such information included in the forwarded message, the recipient would see that the originating source is the mobile client.

For all of the foregoing reasons, we are persuaded by a preponderance of the evidence that as of the time of filing of Eggleston's involved application the Eggleston inventors were not in possession of the so-called "transparency" feature of Eggleston's involved claims 56-63 and 65. Accordingly, Lazaridis has shown that those claims are without written description in the specification and thus are unpatentable under 35 U.S.C. § 112, first paragraph.

Lazaridis Motion 1 is *granted.*

B. Lazaridis Motions 2-4 and 6 and Eggleston Motions 1 and 3

Per 37 C.F.R. § 41.201, Lazaridis Motion 1 is a threshold motion the granting of which deprives Eggleston of standing to continue in this interference. Accordingly, Lazaridis Motions 2-4 and Eggleston Motion 1 are herein *dismissed.*

Lazaridis Motion 6 seeks to exclude Eggleston Exhibits 1004 and 1084, which were relied on, respectively in Eggleston Motion 1 and Reply 1.

Because Eggleston Motion 1 has been dismissed, Lazaridis Motion 6 is herein *dismissed.*

Eggleston Motion 3 seeks to exclude Lazaridis Exhibits 2069, 2083, 2084, and 2085. Eggleston points out that these exhibits were relied on in Lazaridis Opposition 1. Because Eggleston Motion 1 has been dismissed, Eggleston Motion 3 is herein *dismissed.*

Conclusion

It is

ORDERED that Lazaridis Motion 1 is granted;

FURTHER ORDERED that Lazaridis Motions 2-4 and 6 are dismissed; and

FURTHER ORDERED that Eggleston Motions 1 and 3 are *dismissed.*

TORCZON, *Administrative Patent Judge*, joining *dubitante*.

Pace the Court of Appeals for the Federal Circuit,[1] Title 35 of the United States Code does not contemplate a separate law of "copied" claims. Indeed, as the majority opinion suggests, it is not clear what even constitutes a copied claim.

The case law of copied claims dates only to 1992, when the court first announced:

> When interpretation is required of a claim that is copied for interference purposes, the copied claim is viewed in the context of the patent from which it was copied. *DeGeorge v. Bernier*, 768 F.2d 1318, 1322, 226 USPQ 758, 761 (Fed.Cir.1985) (if claim language is ambiguous "resort must be had to the specification of the patent from which the copied claim came").

The court misapprehended its own precedent. The quoted language refers to how an ambiguous count (based in part on a copied claim) should be construed, as is clear from the context.[2] The *DeGeorge* holding makes sense for an ambiguous count because the count has no specification of its own. The court in essence gives precedence to the first party to use the claim language. What the *DeGeorge* court could not have been discussing was unpatentability based on written description since in 1985 the then-Board of Interferences had no authority to decide questions of unpatentability *per se*, including written description.[3] In short, the *Spina* line of cases is based on a patent mistake in applying the court's precedent.

---

1 See *Agilent Technologies, Inc. v. Affymetrix, Inc.*, 567 F.3d 1366 (Fed. Cir. 2009); *Koninklijke Philips Elecs. N.V. v. Cardiac Sci. Operating Co.*, 590 F.3d 1326, 1332 (Fed. Cir. 2010), and *In re Spina*, 975 F.2d 854 (Fed. Cir. 1992).
2 768 F.2d at 1321, section heading: "Improper Count Construction".
3 And, indeed, the patentability of DeGeorge's copied claims for lack of written description was not an issue in the *DeGeorge* opinion.

The *Spina* holding is contrary to the statute. For example, while 35 U.S.C. 112[1] does not expressly require resort to any particular specification,[4] 35 U.S.C. 112[6] does. Thus, *Spina* and its progeny set up an irreconcilable conflict when means-plus-function format is used. The statute requires resort to the claim's specification, while *Spina* requires resort to an alien specification. This conflict is neither necessary nor helpful.

Fortunately, the court has subsequently declined to extend *Spina* to other areas of patent law.[5] Unfortunately, *Spina* continues to bedevil those facing a question of written description in an interference. After nearly two decades, this mistake is overdue for correction.

While I cannot reconcile *Agilent* with the controlling statutes, in view of the controlling judicial precedent, I join the majority's well-reasoned decision.

---

4 Of course, it has long been understood to require reference to the host specification. *E.g.*, *American Fruit Growers v. Brogdex Co.*, 283 U.S. 1, 5 (1931); *Brooks v. Fiske*, 56 U.S. (15 How.) 212, 215 (1853).

5 *Rowe v. Dror*, 112 F.3d 473, 479 (Fed. Cir. 1997); *Cultor Corp. v. A.E. Staley Mfg. Co.*, 224 F.3d 1328, 1332 (Fed. Cir. 2000); *Leviton Mfg. Co. v. Universal Security Instr., Inc.*, 606 F.3d 1353, 1361 (Fed. Cir. 2010).

By Electronic Transmission:

Attorney for Junior Party Lazaridis:

Barbara Clarke McCurdy, Esq.
Steven L. Park, Esq.
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
901 New York Avenue, N.W.
Washington, D.C. 20001-4413

Tel: 202-408-4000
Email: barbara.mccurdy@finnegan.com
Email: steven.park@finnegan.com

Attorney for Senior Party Eggleston:

Charles L. Gholz, Esq.
W. Todd Baker, Esq.
Alexander B. Englehart, Esq.
Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Va 22314

Tel: 703-413-3000
Email: cgholz@oblon.com
Email: tbaker@oblon.com
Email: aenglehart@oblon.com